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EXAMINER

CHEVALIER, ALICIA ANN

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/523,942
Filing Date: February 08, 2005
Appellant(s): ANTONINI, FRED A.

Daren C. Davis
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 5, 2009 appealing from the Office action mailed June 25, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct.

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It is noted that Appellant has not listed the obviousness-type double patenting rejections over copending Applications 11/072382 and 10/5243967, in the grounds of rejection to be reviewed on appeal.

(7) Claims Appendix

A substantially correct copy of appealed claim 1 appears on page A1 of the Appendix to the appellant's brief. The minor errors are as follows: it does not include the amendments to the claim that were filed March 12, 2008.

Claim 1 should read:

1. A film comprising:
a dimensionally stable, thin plastic film having a smooth surface finish; and
a thin layer of silicone elastomer having a durometer of less than 30 on the Shore A scale disposed on a first surface of the plastic film.

(8) Evidence Relied Upon

6,960,272	TOKAS et al.	11-2005
6,372,323	KOBE et al.	4-2002
5,300,171	BRAUN et al.	4-1994

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

1. Claims 1-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 11/072382. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim the same film.

Application 11/072382 claims a film comprising a dimensionally stable, thin plastic film having a smooth surface finish, and a thin layer of silicone elastomer having a low durometer disposed on a first surface of the plastic film (*claim 1*).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

2. Claims 1-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10/524367 in view of Braun et al. (U.S. Patent No. 5,300,171).

Application 10/524367 claims a film comprising a dimensionally stable, thin (*claim 2*) plastic film (*claim 24*) having a smooth surface finish, and a thin (*claim 2*) layer of silicone elastomer (*claims 17 and 19*) disposed on a first surface of the plastic film (*claims 1 and 20*).

Application 10/524367 fails to claim that the silicone has a low durometer.

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Braun discloses a flexible tape (*title*) made of silicone with a Shore A durometer hardness between 30 and 70 (*col. 4, line 53 through col. 5, line 7*).

Therefore, the exact durometer of the silicone elastomer layer is deemed to be a result effective variable with regard to the flexibility of the article. It would require routine experimentation to determine the optimum value of a result effective variable, such as durometer hardness, in the absence of a showing of criticality in the claimed durometer hardness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to have a low durometer hardness such as less than 30 on a the Shore A hardness in order to insure flexibility.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

3. Claims 1, 2, 4-25 and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobe et al. (U.S. Patent No. 6,372,323) in view of Braun et al. (U.S. Patent No. 5,300,171) and evidenced by Tokas et al. (U.S. Patent No. 6,960,272).

Regarding Appellant's claims 1 and 3, Kobe discloses a film comprising a plastic film (*additional backing layer, col. 5, lines 26-28 and 51-67*) and a silicone elastomer (*backing layer with stems, col. 5, lines 8-9 and col. 9, lines 48-49*) disposed on a first surface of the plastic film (*figure 1*). The plastic film is deemed to be thin (*col. 5, lines 35-36*) and dimensionally stable with a smooth surface, since figure 1 one shows the additional backing is flat, i.e. no texturing/projections, and is used to as a stabilizing layer (*col. 5, lines 26-27*). The silicone elastomer film is deemed to be thin (*col. 5, lines 35-36*). Kobe further discloses that the slip

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control article is flexible (*col. 1, lines 45-47*). Kobe discloses that the silicone elastomer layer has a Shore hardness A of less than about 90 (*col. 3, lines 5-7*).

Kobe fails to disclose that the silicone elastomer has a low durometer, more specifically less than 30 on the Shore A scale.

Braun discloses a flexible tape (*title*) made of silicone with a Shore A durometer hardness between 30 and 70 (*col. 4, line 53 through col. 5, line 7*).

Therefore, the exact durometer of the silicone elastomer layer is deemed to be a result effective variable with regard to the flexibility of the article. It would require routine experimentation to determine the optimum value of a result effective variable, such as durometer hardness, in the absence of a showing of criticality in the claimed durometer hardness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated by the fact that Kobe desires a flexible article to have a low durometer hardness such as less than 30 on a the Shore A hardness in order to insure flexibility.

Regarding Appellant's claim 2, Kobe discloses that the plastic film can be made of thermoplastic elastomers, such as polyolefin (*col. 5, lines 60-61*). Tokas shows that thermoplastic elastomers with polyolefinic material has a low surface energy, such as 28-30 dynes/cm (*col. 2, line 12-22*).

The limitation "co-extruded" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless

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Appellant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

Regarding Appellant's claim 4, Kobe discloses that the film further comprises an adhesive disposed on a second surface of the plastic film (*col. 5, line 29 and figure 1*).

Regarding Appellant's claim 5, Kobe discloses that the film further comprises a releasable liner for covering the adhesive prior to use (*col. 5, line 29 and figure 1*).

Regarding Appellant's claims 6-10, the limitation "polished" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Appellant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. However, the method limitation "polished" does impart structure to the film, which is a flat or non-raised surface. Therefore, Kobe meets the limitation that the silicone elastomer has a polished surface finish, since figures 1 and 8 clearly show non-raised or flat portion on the article. Kobe also meets the limitation the polished surface finish is smooth since figure 1 clearly shows smooth, i.e. flat, portions between the stems. The surface is deemed to be heavily textured (*figure 8*). As seen by figures 8 and 1 the silicone elastomer has textured and polished surface finish.

The limitation "polished surface finish is formed by a casting means having a polished surface finish" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Appellant presents evidence

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from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Kobe discloses a surface that is textured and flat.

Regarding Appellant's claim 11, Kobe discloses that the textured is in an array of upraised dimples (*figures 1 and 8*).

Regarding Appellant's claim 12, the silicone elastomer is deemed to have a matte finish since it contains projections (*figures 1 and 8*).

Regarding Appellant's claim 13, the limitation "heat-stabilized" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Appellant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

Regarding Appellant's claim 14, Kobe discloses that the plastic film has a thickness of about 0.002 inches or less (*col. 5, lines 35-36*).

Regarding Appellant's claims 15-18, Kobe discloses that the plastic film or silicone elastomer can be tinted with pigments or dyes (*col. 5, lines 62-67*). Therefore, either the plastic film or silicone elastomer is deemed to comprise a graphical indicia, since either one may contain pigments or dyes.

Regarding Appellant's claims 19-24, the limitations "for application on the fingertips of users," "for application on handheld devices," "for placement onto a material handling device," "for use on equipment used in games" and "configured to be sewn into fabric" are deemed to be

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statements with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Furthermore, it is noted that Kobe's article is useful in golf clubs, baseball bats, household articles, non-slip walking surfaces etc. (*col. 1, lines 60-64*). The intended uses of Kobe's article include Appellant's intended uses for their film.

Regarding Appellant's claims 36-40, Kobe discloses a film comprising a plastic film (*additional backing layer, col. 5, lines 26-28 and 51-67*) and a silicone elastomer (*backing layer with stems, col. 5, lines 8-9 and col. 9, lines 48-49*) disposed on a first surface of the plastic film (*figure 1*). The plastic film is deemed to be thin (*col. 5, lines 35-36*) and dimensionally stable with a smooth surface, since figure 1 one shows the additional backing is flat, i.e. no texturing/projections, and is used to as a stabilizing layer (*col. 5, lines 26-27*). The silicone elastomer film is deemed to be thin (*col. 5, lines 35-36*). Kobe further discloses that the slip control article is flexible (*col. 1, lines 45-47*). The plastic film can be made of thermoplastic elastomers, such as polyolefin (*col. 5, lines 60-61*). Tokas shows that thermoplastic elastomers with polyolefinic material has a low surface energy, such as 28-30 dynes/cm (*col. 2, line 12-22*). The film further comprises an adhesive disposed on a second surface of the plastic film (*col. 5, line 29 and figure 1*) and a releasable liner for covering the adhesive prior to use (*col. 5, line 29 and figure 1*).

Kobe fails to disclose that the silicone elastomer has a low durometer, more specifically less than 30 on the Shore A scale.

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Braun discloses a flexible tape (*title*) made of silicone with a Shore A durometer hardness between 30 and 70 (*col. 4, line 53 through col. 5, line 7*).

Therefore, the exact durometer of the silicone elastomer layer is deemed to be a result effective variable with regard to the flexibility of the article. It would require routine experimentation to determine the optimum value of a result effective variable, such as durometer hardness, in the absence of a showing of criticality in the claimed durometer hardness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated by the fact that Kobe desires a flexible article to have a low durometer hardness such as less than 30 on a the Shore A hardness in order to insure flexibility.

The limitation “heat-stabilized” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Appellant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

(10) Response to Argument

Appellant has not presented arguments to rebut the obviousness-type double patenting rejections of record. Therefore, it is requested that the obviousness-type double patenting rejections of record be summarily affirmed.

Appellant's arguments in the Appeal Brief, filed February 5, 2009, regarding the 35 U.S.C. 103(a) as being unpatentable over Kobe in view of Braun and evidenced by Tokas of record have been carefully considered but are deemed unpersuasive.

Appellant argues that the references cited do not teach or suggest "a dimensionally stable, thin plastic film" as required by claim 1.

Appellant has not clearly pointed out how Kobe does not teach a dimensionally stable, thin plastic film. Therefore, Appellant's argument is unpersuasive.

Appellant argues that the references cited do not teach or suggest "a thin layer of silicone elastomer having a durometer of less than 30 on the Shore A scale disposed on a first surface of the plastic film." as required by claim 1. Appellant further states that Kobe and Braun fail to disclose a silicone elastomer having a durometer of less than 30 on the Shore A scale. Appellant further states that the characteristic of having a durometer of less than 30 on the Shore A scale provides critical frictional properties to the claimed film and, thus, the durometer is not merely a result effective variable.

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First, Kobe discloses that the that the thin layer of silicone elastomer has a durometer of less than about 90 on the Shore A scale (*Kobe, col. 3, lines 5-7*). Braun discloses a flexible tape (*title*) made of silicone with a Shore A durometer hardness between 30 and 70 such that this allows a tape to be made which can be formed and stored in roll form (*Braun, col. 4, line 53 through col. 5, line 7*). Second, MPEP 2144.05 clearly states that a prior art reference that discloses a range encompassing a somewhat narrower claimed range is sufficient to establish a prima facie case of obviousness and a range can be disclosed in multiple prior art references instead of in a single prior art. Therefore, in view of Kobe's range of Shore A scale range which encompass Appellant's claimed narrower range and the disclosure of Braun showing that lower Shore A values are more flexible, the exact durometer of the silicone elastomer layer is deemed to be a result effective variable with regard to the flexibility of the article. It would require routine experimentation to determine the optimum value of a result effective variable, such as durometer hardness, in the absence of a showing of criticality in the claimed durometer hardness.

MPEP 2144.05 II B. One of ordinary skill in the art would have been motivated by the fact that Kobe desires a flexible article to have a low durometer hardness such as less than 30 on a the Shore A hardness in order to insure flexibility. Furthermore, Appellant's statement of the critical frictional properties of the Shore A hardness value is not evidence showing the criticality of the claimed durometer harness. Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art. The arguments of counsel cannot take the place of evidence in the record. See MPEP § 716.01(c) for examples of attorney statements

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which are not evidence and which must be supported by an appropriate affidavit or declaration.

MPEP 2145 I.

Appellant further traverses the examiner's contention that the ANTONINI Declaration only contains opinions and arguments concerning the prior art. Appellant points out that the declaration explains why it would not have been obvious to one of ordinary skill in the art at the time of the present invention to dispose a thin layer of silicone elastomer have in a durometer of less than 30 on the Shore A scale on a surface of dimensionally stable, thin plastic film.

Again, Appellant's ANTONINI Declaration filed March 12, 2008 is deemed to be unpersuasive because it only contains ANTONINI's opinions and arguments regarding the prior art and does not provide any evidence from which the examiner could reasonably conclude that the claimed product differs in kind from the prior art. Specifically, Antonini states "Kobe disclose that the slip control device operates primarily as a result of the frictional characteristics of the upstanding stems, the upstanding stems must be made from a material that can withstand the shear forces exerted on the upstanding stems during use. Accordingly, Kobe uses elastomers having higher elastic moduli, which also exhibit higher harnesses than a silicone elastomer having a durometer of less than 30 on the Shore A scale." Appellant has not provided any values for the elastic moduli with corresponding durometer measurements on the Shore A scale of the instant invention or the prior art or any evidence to this fact. Therefore, since the declaration does not contain any evidence such as values of the elastic moduli or proof that the instant invention has property not found the prior, the declaration is deemed unpersuasive.

Appellant argues that claims 6-10 are separately allowable over the cited reference since they do not teach or suggest “a polished surface finish.”

As stated in the above rejection, the limitation “polished” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Appellant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. However, the method limitation “polished” does impart structure to the film, which is a flat or non-raised surface. Therefore, Kobe meets the limitation that the silicone elastomer has a polished surface finish, since figures 1 and 8 clearly show non-raised or flat portion on the article. Kobe also meets the limitation the polished surface finish is smooth since figure 1 clearly shows smooth, i.e. flat, portions between the stems. Furthermore, Appellant’s instant specification is silent to the desired surface topography that results from a “polished surface finish.” The recitation on page 5, lined 2-3, of “the phrase ‘surface finish’ will be used herein to describe the surface of materials on very fine, or microscopic, scale,” is not a disclosure of the surface topography gained by a “polished surface finish.” Therefore, the non-raised/flat surface of Kobe is deemed to read on Appellant's polished surface finish.

Appellant argues that claim 11 is separately allowable over the cited reference since they do not teach or suggest “an array of upraised dimples.” Appellant further adds that a dimple is “an indented, hollowed, or depressed area in the surface of something.”

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First, the examiner is unable to find support for Appellant's definition of dimple in the instant specification. Second, the spaces between the projections in Kobe are depression areas. Therefore, Kobe discloses dimples, See figures 1 and 8.

Appellant argues that claim 12 is separately allowable over the cited reference since they do not teach or suggest "a matte finish."

Appellant's instant specification is silent to the desired surface topography that results from a "matte finish." Furthermore, Appellant has not provided evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from the prior art. Furthermore, attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art. The arguments of counsel cannot take the place of evidence in the record. See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration. MPEP 2145.

Appellant argues that claims 13 and 36-40 is separately allowable over the cited reference since they do not teach or suggest "a heat stabilized plastic film."

As stated above, the limitation "heat-stabilized" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Appellant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, Appellant

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has not provided any evidence showing how the instant claimed product differs from the prior because it was heat stabilized. The burden is on Appellant to show how the invention differs.

Appellant argues that claim 16 is separately allowable over the cited reference since they do not teach or suggest “graphical indicia associated with the plastic film.” Appellant further argues that the pigment and dye additives are of the type that are added to a batch of material, rather than to create a graphical indicia.

Appellant has not clearly pointed out how the pigments and dyes or Kobe do not define graphical indicia, since the pigments and dyes will create color and different artistic renderings. Furthermore, where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. MPEP 2112.01 III.

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Appellant argues that claim 25 is separately allowable over the cited reference since they do not teach or suggest “a label stock having indicia adhered to the plastic film.”

Appellant has not clearly pointed out how the pigments and dyes or Kobe do not define graphical indicia, since the pigments and dyes will create color and different artistic renderings. Furthermore, Appellant has not shown how Kobe does not encompass “a label stock,” since Kobe meets all the structural limitations of the claims.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
/Alicia Chevalier/
Primary Examiner, Art Unit 1794

Conferees:

/David R. Sample/
Supervisory Patent Examiner, Art Unit 1794

/Jennifer Michener/
QAS, TC1700